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EXAMINER

ABEL JALIL, NEVEEN

ART UNIT PAPER NUMBER

2175

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,856

Applicant(s)

FITZPATRICK ET AL.

Examiner

Neveen Abel-Jalil

Art Unit

2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06-August-2004 has been entered.

2. The amendment filed on 06-August-2004 has been received and entered. Claims 1-17 are pending

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-11 are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter, specifically, directed towards a data structure.

The Supreme Court has repeatedly held that abstractions are not patentable. "An idea of itself is not patentable". "Rubber Tip Pencil Co. V. Howard", 20 Wall.498, 07. Phenomena of nature, though just discovered, mental processes, abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work "Gottschalk v. Benson", 175 USPQ 673, 675 (S Ct 1972). It is a common place

Art Unit: 2175

that laws of nature, physical phenomena, and abstract ideas are not patentable subject matter "Parker v. Flook", 197 USPQ 193, 201 (S Ct 1978).

Database Structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical "things" nor statutory processes. Applicant's claims are not within any of the statutory classes. "A database structure" should define structural and functional interrelationships between data structures or functional parts and a computer system which permit the data functions to be realized, and is statutory.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolnick et al. (U.S. Pub. No. 2002/0023230 A1) in view of Harari (U.S. Pub. No. 2002/0016857 A1), and further in view of Bloebaum et al. (U.S. Pub. No. 2002/0098849 A1).

As to claims 1, and 12, Bolnick et al. discloses a method for generating a list of contacts (See Bolnick et al. page 7, paragraphs 0115-0118), a machine readable storage having stored thereon a computer program for generating a list of contacts (See Bolnick et al. page 2, paragraph 0025), said machine readable storage having a plurality of code

Art Unit: 2175

sections executable by a machine for causing the machine to perform a series of steps comprising the steps of:

first retrieving a plurality of contacts from an exposed, remotely accessible contact list (See Bolnick et al. pages 2-3, paragraphs 0026-0027) associated with a user (See Bolnick et al. page 9, paragraphs 0170-0171),

first comparing said first retrieved contacts to stored contacts in a locally accessible contact list (See Bolnick et al. page 8, paragraphs 0162-0167, wherein “comparator” reads on “out-of-date”) associated with a different user (See Bolnick et al. page 4, paragraphs 0065-0066, wherein “associated with a different user” reads on “to be shared”);

second retrieving a plurality of contacts from an exposed, remotely accessible contact list associated with one of said first retrieved contacts; second comparing said second retrieved contacts to said locally stored contacts (See Bolnick et al. page 8, paragraphs 0167-0171, also see Bolnick et al. abstract, and see Bolnick et al. page 5, paragraphs 0068-0070).

Bolnick et al. does not disclose first identifying common contacts among said first compared contacts; second identifying common contacts among said second compared contacts.

Harari discloses first identifying common contacts among said first compared contacts; second identifying common contacts among said second compared contacts (See Harari page 3, paragraphs 0031-0033, also see Harari page 5, paragraphs 0043-0046).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. to include first identifying common contacts among said first compared contacts; second identifying common contacts among said second compared contacts.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. by the teaching of Harari to include first identifying common contacts among said first compared contacts; second identifying common contacts among said second compared contacts because it provides for efficient database organization and access thereby reducing processing time and business expenses.

Bolnick et al. as modified still does not teach the exposed, remotely accessible contact list defining a first set; said locally accessible contact list defining a second set distinct from said first set; generating and storing a common contacts list, the common contacts list defining yet another distinct set and containing said identified common contacts.

Bloebaum et al. teaches the exposed, remotely accessible contact list defining a first set (See Bloebaum et al. page 3, paragraphs 000032-0034);

said locally accessible contact list defining a second set distinct from said first set (See Bloebaum et al. page 3, paragraphs 000037-0039);

generating and storing a common contacts list, the common contacts list defining yet another distinct set and containing said identified common contacts (See Bloebaum et al. pages 2-3, paragraphs 0029-0034).

Art Unit: 2175

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified Bolnick et al. as modified to include the exposed, remotely accessible contact list defining a first set; said locally accessible contact list defining a second set distinct from said first set; generating and storing a common contacts list, the common contacts list defining yet another distinct set and containing said identified common contacts.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified Bolnick et al. as modified by the teaching of Bloebaum et al. to include the exposed, remotely accessible contact list defining a first set; said locally accessible contact list defining a second set distinct from said first set; generating and storing a common contacts list, the common contacts list defining yet another distinct set and containing said identified common contacts because it provides alternate source of information for efficient access of records at all times (See Bloebaum et al. page 1, paragraph 0006).

As to claims 2, and 13, Bolnick et al. as modified discloses further comprising the step of repeating said second retrieving, second comparing and second identifying steps for each first retrieved contact not identified as a common contact in said first identifying step (See Bolnick et al. page 4, paragraph 0065, wherein “not identified” reads on “determination of shared access”, also see Bolnick et al. page 4, paragraph 0067, also see Bolnick et al. pages 5-6, paragraphs 0086-0087).

Art Unit: 2175

As to claims 3, and 14, Bolnick et al. as modified discloses wherein said second retrieving step comprises the step of second retrieving a plurality of contacts from an exposed, remotely accessible contact list associated with one of said first retrieved contacts not identified as a common contact in said first identifying step (See Bolnick et al. page 6, paragraph 0108, wherein “not identified as common contact” reads on “can be integrated into member’s display list”).

As to claims 4, and 15, Bolnick et al. discloses a method generating a list of common contacts (See Bolnick et al. page 7, paragraphs 0115-0118), a machine readable storage having stored thereon a computer program for generating a list of common contacts, said machine readable storage having a plurality of code sections executable by a machine for causing the machine to perform a series of steps, said steps comprising:

Bolnick et al. does not disclose exchanging at least two contact lists over a physical communications link, wherein each contact list corresponds to a different user; comparing contacts in said exchanged contact lists to identify matching contacts.

Harari discloses exchanging at least two contact lists over a physical communications link, wherein each contact list corresponds to a different user (See Harari page 1, paragraphs 0006-0017);

comparing contacts in said exchanged contact lists to identify matching contacts (See Harari page 3, paragraphs 0031-0033, also see Harari page 5, paragraphs 0043-0046).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. to include exchanging at

Art Unit: 2175

least two contact lists over a physical communications link, wherein each contact list corresponds to a different user; comparing contacts in said exchanged contact lists to identify matching contacts.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. by the teaching of Harari to include exchanging at least two contact lists over a physical communications link, wherein each contact list corresponds to a different user; comparing contacts in said exchanged contact lists to identify matching contacts because it provides for efficient database organization and access thereby reducing processing time and business expenses.

Bolnick et al. as modified still does not teach defines a distinct set different from the other; and generating and storing a contact list defining yet another distinct set and containing said matched contacts.

Bloebaum et al. teaches defines a distinct set different from the other (See Bloebaum et al. page 3, paragraphs 000037-0039);

and generating and storing a contact list defining yet another distinct set and containing said matched contacts (See Bloebaum et al. pages 2-3, paragraphs 0029-0034).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified Bolnick et al. as modified to include defines a distinct set different from the other; and generating and storing a contact list defining yet another distinct set and containing said matched contacts.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified Bolnick et al. as modified by the teaching of Bloebaum et al. to include defines a distinct set different from the other; and generating

Art Unit: 2175

and storing a contact list defining yet another distinct set and containing said matched contacts because it provides alternate source of information for efficient access of records at all times (See Bloebaum et al. page 1, paragraph 0006).

As to claims 5, and 16, Bolnick et al. discloses wherein said exchanging step comprises the steps of: establishing a wireless communications link; and, exchanging said contact lists over said established wireless communications link (See Bolnick et al. page 8, paragraph 0167, wherein “exchanging” reads on “sharing”)

As to claims 6, and 17, Bolnick et al. discloses a method of generating a list of common contacts (See Bolnick et al. page 7, paragraphs 0115-0118), A machine readable storage having stored thereon a computer program for generating a list of common contacts, said machine readable storage having a plurality of code sections executable by a machine for causing the machine to perform a series of steps (See Bolnick et al. page 2, paragraph 0025), said steps comprising:

accessing a contact list in a remotely accessible database of contacts (See Bolnick et al. page 4, paragraphs 0063-0065, also see Bolnick et al. page 6, paragraph 0108);

providing a visual hyperlink for each matching contact produced by said comparing step (See Bolnick et al. page 1, paragraph 0013, also see Bolnick et al. page 8, paragraphs 0167-069).

Bolnick et al. does not disclose comparing contacts in said contact list with contacts in a stored database of contacts; and said contact list and said contacts in a stored

Art Unit: 2175

database of contacts each corresponding to a different user; and producing matching contacts as a result of said comparing.

Harari discloses comparing contacts in said contact list with contacts in a stored database of contacts; and said contact list and said contacts in a stored database of contacts each corresponding to a different user (See Harari page 1, paragraphs 0006-0017); and producing matching contacts as a result of said comparing (See Harari page 3, paragraphs 0031-0033, also see Harari page 5, paragraphs 0043-0046).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. to include comparing contacts in said contact list with contacts in a stored database of contacts; and said contact list and said contacts in a stored database of contacts each corresponding to a different user; and producing matching contacts as a result of said comparing.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. by the teaching of Harari to include comparing contacts in said contact list with contacts in a stored database of contacts; and said contact list and said contacts in a stored database of contacts each corresponding to a different user; and producing matching contacts as a result of said comparing because it provides for efficient database organization and access thereby reducing processing time and business expenses.

Bolnick et al. as modified still does not teach defining a set being stored; and defining another distinct set.

Art Unit: 2175

Bloebaum et al. teaches defining a set being stored; and defining another distinct set (See Bloebaum et al. page 3, paragraphs 00037-0039, and see Bloebaum et al. pages 2-3, paragraphs 0029-0034).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified Bolnick et al. as modified to include defining a set being stored; and defining another distinct set.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified Bolnick et al. as modified by the teaching of Bloebaum et al. to include defining a set being stored; and defining another distinct set because it provides alternate source of information for efficient access of records at all times (See Bloebaum et al. page 1, paragraph 0006).

As to claim 7, Bolnick et al. discloses a common contact identification system (See Bolnick et al. page 7, paragraphs 0115-0118) comprising:

at least two contact lists, each said contact list comprising a plurality of contacts, each said contact list having a publicly accessible interface through which said contacts can be accessed remotely (See Bolnick et al. page 2, paragraphs 0018, also see Bolnick et al. pages 2-3, paragraphs 0025-0027, wherein “publicly accessible” reads on “Internet”, also see Bolnick et al. page 4, paragraph 0065, wherein “contact lists” reads on “address book”, also see Bolnick et al. page 3, paragraphs 0034-0036, wherein “accessed remotely” reads on “Instant Messenger”);

a comparator for comparing contacts in each of said at least two contact lists, said comparator identifying matching contacts in each of said at least two contact lists (See

Art Unit: 2175

Bolnick et al. figure 7, shows two PDA's indicating two contact lists, also see Bolnick et al. page 10, paragraphs 0238-0239, also see Bolnick et al. page 9, paragraph 0202, and see Bolnick et al. page 8, paragraphs 0167-0169).

Bolnick et al. does not disclose each said contact list corresponding to a different user; a common contact list resulting from the comparison and comprising contacts matched by said comparator.

Harari discloses each said contact list corresponding to a different user (See Harari page 1, paragraphs 0006-0017);

a common contact list resulting from the comparison and comprising contacts matched by said comparator (See Harari page 3, paragraphs 0031-0033, also see Harari page 5, paragraphs 0043-0046).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. to include each said contact list corresponding to a different user; a common contact list resulting from the comparison and comprising contacts matched by said comparator.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. by the teaching of Harari to include each said contact list corresponding to a different user; a common contact list resulting from the comparison and comprising contacts matched by said comparator because it provides for efficient database organization and access thereby reducing processing time and business expenses.

Bolnick et al. as modified still does not teach defining a distinct set; and defining yet another distinct set.

Art Unit: 2175

Bloebaum et al. teaches defining a distinct set; and defining yet another distinct set (See Bloebaum et al. page 3; paragraphs 000037-0039, and see Bloebaum et al. pages 2-3, paragraphs 0029-0034).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified Bolnick et al. as modified to include defining a distinct set; and defining yet another distinct set.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified Bolnick et al. as modified by the teaching of Bloebaum et al. to include defining a distinct set; and defining yet another distinct set because it provides alternate source of information for efficient access of records at all times (See Bloebaum et al. page 1, paragraph 0006).

As to claim 8, Bolnick et al. as modified discloses wherein each said contact list is stored in a storage medium selected from the group consisting of a database (See Bolnick et al. page 3, paragraph 0032), a contact management program data store (See Bolnick et al. page 2, paragraph 0014), an e-mail program address book; an instant messenger address book, a cellular phone address book, and a personal digital assistant address book (See Bolnick et al. page 10, paragraphs 0227-0231, wherein "cellular phone" reads on "wireless").

As to claim 9, Bolnick et al. as modified discloses further comprising a communications link between said contact lists over which said contacts in said contact

Art Unit: 2175

lists can be transmitted (See Bolnick et al. pages 2-3, paragraphs 0026-0027, wherein “communication link” reads on “Internet”).

As to claim 10, Bolnick et al. as modified discloses wherein said communications link is selected from the group consisting of an infrared communications link, a short range radio frequency communications link, and a TCP/IP wireline link (See Harari page 1, paragraph 0017).

As to claim 11, Bolnick et al. as modified discloses wherein said common contact list comprises at least one hyperlinked address of a matched contact (See Bolnick et al. page 1, paragraph 0013, also see Bolnick et al. page 8, paragraphs 0167-069).

Response to Arguments

7. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 703-305-8114. The examiner can normally be reached on 8:30AM-5: 30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 703-305-3830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2175

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Neveen Abel-Jalil
September 29, 2004


CHARLES RONES
PRIMARY EXAMINER